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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/06/2005

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EXAMINER

GALVEZ, JAMES JASON

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

08/670,119

Applicant(s)

NG ET AL.

Examiner

J. Jason Galvez

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 80.

Claim(s) rejected: 67-78 and 81-86.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


JANET ANDRES
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

It is noted that identical issues are present whether the claims read on a method of using peptides comprising "at least 9 contiguous amino acids" or peptides comprising "at least 16 contiguous amino acids".

Applicants amendment of claims 67 and 68 raises the issue of new matter under 35 U.S.C. § 112, first paragraph, and is maintained for analogous reasons of record in paper no. 0504. The specification does not support the limitation of antagonists comprising 16 contiguous amino acids of any one of SEQ ID NOs. 23-29. The mere fact that SEQ ID NO: 31 is 16 amino acids does not support the recitation of the above mentioned limitation. Applicant has not even defined regions of any of SEQ ID NOs. 23-29 that are responsible for possible antagonistic activity. The new matter rejection would be maintained if Applicant were to amend the claims as presented.

The rejection of claims 67-78 and 81-86 as failing to comply with the enablement requirements under 35 U.S.C. § 112, first paragraph, are maintained for analogous reasons of record in paper no. 0504. There is no enabling support for the limitation of antagonists comprising 16 contiguous amino acids of any one of SEQ ID NOs. 23-29. For example, would sequences comprising any 16 contiguous amino acids of SEQ ID NO: 23, which encompasses sequences outside of the 16 contiguous amino acids, function as an antagonist as claimed? Sequences encompassed by the claims include a myriad of sequences that may have divergent function or may be devoid of function. As such, a person of ordinary skill in the art would not be able to practice the invention commensurate in scope with the claims without undue experimentation.

The rejection of claims 67-78 and 81-86 as failing to comply with the written description requirements under 35 U.S.C. § 112, first paragraph, are maintained for analogous reasons of record in paper no. 0504. Applicant has still failed to describe the genus of molecules used in the claimed invention in such a way that a person of ordinary skill in the art would be able to identify members of the claimed genus. As the claims read, the sequences claimed need only have 16 contiguous amino acids to any one of SEQ ID NOs. 23-29 with no other restriction on what the sequences encompass because the sequences are claimed using open language, i.e. sequences comprising. Therefore, sequences outside of the 16 contiguous amino acids could be any number of amino acid sequences. Furthermore, Applicant has not even defined regions of any of SEQ ID NOs. 23-29 that are responsible for antagonist activity.